

REMARKS

Claims 16-40 are currently pending. Claims 1-15 were previously cancelled. Claims 16-22, 31-34 and 36-38 are currently withdrawn as directed to a non-elected invention. Claim 24 is currently amended to provide proper antecedent basis. Applicants respectfully request that this amendment be entered after final. No new matter is added.

Claim Rejections - 112

Claim 24 is rejected under 35 USC 112, 2nd paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 has been amended to remove the limitation of a “control and calculating unit” and replace it with “means for setting.” Applicants believe this rejection is now moot.

102 Rejections

Claims 23-30, 35, 39 and 40 are rejected under 35 USC 102(b) as allegedly anticipated by U.S. Patent 5,744,027 to Connell et al. (“Connell”).

With respect to independent claims 23 and 26, Connell fails to disclose “a means for setting a dialysing fluid flow rate Q_{d_b} during a dialysis treatment *such that at the end of the pre-set treatment period T_B , the at least one receiving unit is either empty or contains a pre-set residual volume of the at least one dialysing fluid concentrate*” as claimed. The Examiner has identified the receiving unit as the third concentrate supply 116, the means for providing water as water source 82, and the means for mixing as mixing chamber 120 in Connell. Although Connell discloses a UF/PROP system 516 that controls the dialysis flow rate, there is no disclosure that the system 516 adjusts the flow rate *so that* the receiving unit is empty or contains a pre-set residual volume of the concentrate at the end of the treatment time. Although Connell may disclose that the equalizer chambers are emptied, there is no disclosure of the concentrate supply 116 being emptied of concentrate.

The Examiner states that “[r]egarding the limitations reciting *configured to* language, the examiner considers these to be statements with regard to intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. (MPEP § 211.02)” (Office Action, page 3).

However, claims 23 and 26 invoke “means plus function” claim language as authorized by 35 U.S.C. § 112, paragraph 6. According to the MPEP, “the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim.” MPEP § 2182 (emphasis added). “Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept.” *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1445 n. 5 (Fed. Cir. 1984) (emphasis added); *see also Ishida Co., Ltd. v. Taylor*, 221 F.3d 1310, 1316 (Fed. Cir. 2000) (literally meeting a means-plus-function clause “requires that the accused device perform a function identical to that identified in the means clause” (emphasis added)). Only “if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.” MPEP § 2182. According to the MPEP, the first step in making a prima facie case of equivalence is to determine if the prior art element performs the function specified in the claim. MPEP § 2183. Applicants submit that the Examiner has ignored the initial step of the analysis, as the device in Connell does not perform an identical function.

According to case law, the prior art reference must perform the complete identical function as recited in the claims. In *Ex Parte Powers*, the Board held that “[f]or a means-plus-function limitation to read on a device, the device must employ means identical or equivalent to the corresponding structures, materials, or acts described in the specification and must also perform the identical function as specified in the limitation.” *Ex Parte Powers*, 2003 Pat. App. LEXIS 52, 6 (BPAI 2003). The Board found that “Kirschke’s metal ruler 40 and ruler slide 41 perform the identical function specified by the limitation at issue, i.e., they are reflective and changeable in response to downward movement of the vertical test arm so that a user can direct a focused light source toward them and observe when the pipeline inspection device is far from the user, thereby indicating to the user any downward movement of the vertical test arm.” *Id.* The claim at issue recited the following limitation: “reflective means changeable in response to

downward movement of the vertical test arm, so that a user can direct a focused light source toward them and thereby observe the state of said reflective means when the pipeline inspection device is far from the user, thereby indicating to the user any downward movement of the vertical test arm.” *Id.* at 2. In *Ex Parte Powers* the Board thus specified that the function of a means-plus-function limitation includes all the modifying language following “reflective means” in the claim.

Additionally, the Federal Circuit in *IMS Tech. Inc. v. Haas Automation, Inc.* held that the full function of a means-plus-function clause must be given weight. In that case, the claim recited an “interface means for transferring a control program and control parameters from an external medium into said alterable memory.” *IMS Tech. Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1427 (Fed. Cir. 2000). The Appellant argued that the corresponding structure needed only to perform a “transferring” function, regardless of whether the transferring was done “from an external medium.” *Id.* at 1431. The Federal Circuit disagreed. The Federal Circuit held that the full means-plus-function clause, including the phrase “from an external medium,” must be given weight. Thus, the Court ruled that “the claims require the interface means to transfer data to the RAM *from an external medium*, i.e., a tape cassette, not just from the tape cassette transport.” *Id.* (emphasis added). As discussed above, Connell does not perform the identical function as claimed in the pending claims.

Thus, the Examiner cannot simply ignore part of the means-plus-function limitation. According to case law, the limitation, “such that at the end of the pre-set treatment period T_B , the at least one receiving unit is either empty or contains a pre-set residual volume of the at least one dialysing fluid concentrate” is part of the means for detecting and cannot be ignored as simply “intended use.” Thus, Connell does not disclose or suggest all the limitations of independent claims 23 and 26, and all claims dependent therefrom.

Conclusion

The Office may charge any additional fees required, or credit any overpayments, to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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